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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/528,258

03/17/2005

Lauri Piikivi

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EXAMINER

PAIK, STEVE S

ART UNIT

PAPER NUMBER

2876

MAIL DATE

DELIVERY MODE

06/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary

Application No.

10/528,258

Applicant(s)

PIIKIVI, LAURI

Examiner

Steven S. Paik

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/9/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Receipt is acknowledged of the Preliminary Amendment filed March 17, 2005.

Specification

2. The disclosure is objected to because of the following informalities: The continuation data should be inserted between the title of the invention and the first line of the Specification. Appropriate correction is required.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 1-14 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-14 of prior U.S. Patent No. 6,776,339. This is a double patenting rejection.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 2876

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 15 and 16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 9 of U.S. Patent No. 6,776,339. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is a broader recitation of the above-mentioned patents. The claims are compared below to support the double patenting rejection.

Claims 15 and 16 of the present application:

15. (New) A smart card router module (33), for use as a component of a mobile cellular terminal including a cellular telephone functionality for communication via a cellular communication network and having a terminal interface (32), characterized in that the smart card router module (33) is responsive to a radiofrequency (RF) communication signal (RF in air) issuing from a contactless smart card reader (35), for demodulating the RF communication signal (RF in air) and providing either a demodulated communication traffic signal (Sin) routed to the smart card application host (34) or a demodulated communication traffic signal (Uin) routed to the terminal interface (32), the smart card router module (33) determining the routing based on information conveyed by the RF communication signal (RF in air).

16. (New) A computer program product comprising a computer readable storage structure embodying computer program code thereon for execution by a computer processor hosted by a mobile cellular terminal, wherein said computer program code comprises instructions for performing a method including:

a step (61) of receiving from a contactless smart card reader (35) a radiofrequency (RF) communication signal pertinent to at least one smart card application hosted by the mobile cellular terminal;

a step (62) of examining the received communication signal so as to determine where to route the received communication signal, including possibly routing the communication signal to the at least one smart card application or to a terminal interface of the mobile cellular terminal or to an RF antenna (33c) of the mobile cellular terminal for radiative transmission to a system (31a 31b) related to the at least one smart card application; and

a step (63) of routing the communication signal to the destination so determined.

Claims 1 and 9 of U.S. Patent No. 6,776,339

1. A mobile cellular terminal (30) including a cellular telephone functionality for communication via a cellular communication network and having a terminal interface (32), characterized in that the mobile cellular terminal (30) includes a smart card application host (34) and also a smart card router (33), the smart card router (33) responsive to a radiofrequency (RF) communication signal (RF in air) issuing from a contactless smart card reader for (35), for demodulating the RF communication signal and (RF in air) and providing either a demodulated communication traffic signal (Sin) routed to the smart card application host (34) or a demodulated communication traffic signal (Uin) routed to the terminal interface (32), the smart card router (33) determining the routing based on information conveyed by the RF communication signal (RF in air).

9. A method for use by a mobile cellular terminal (30) including a cellular telephone functionality in communicating with a contactless smart card reader (35), the mobile cellular terminal configured for communication via a cellular communication network and including a smart card application host hosting at least one smart card application (34-134-2), the method characterized by: a step (61) of receiving from the contactless smart card reader (35) a radiofrequency (RF) communication signal pertinent to the at least one smart card application; a step (62) of examining so as to determine where to route the received communication signal including possibly routing the signal to the at least one smart card application (34-134-2) or to a terminal interface of the mobile cellular terminal or to an RF antenna (33c) for radiative transmission to a system (31a 31b) related to the at least one smart card application; and a step (63) of routing the communication signal to the destination so determined.

As shown above, claims 15 and 16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 9 of U.S. Patent No. 6,776,339.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 571-272-2404. The examiner can normally be reached on Monday - Friday 6:30a-3:00p (Maxi-Flex*).

Art Unit: 2876

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Steven S. Paik
Primary Examiner
(steve.paik@uspto.gov)
Art Unit 2876

ssp